

Serial No. 09/829,536
Attorney Ref. No. 1205-007/JRD
Reply to Office Action Dated: April 8, 2005

REMARKS

A non-final Office Action, dated April 4, 2005, rejects pending claims 1-20. Claims 1 and 5 have been amended herein, and claim 7 has been cancelled. Reconsideration is respectfully requested in light of the foregoing amendments and the following remarks.

35 USC § 103

Applicants respectfully traverse the examiner's rejection of claims 1-20 as being rendered obvious by the references of record. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so" [MPEP § 2143.01]. Applicants traverse the examiner's rejections of these claims on at least the following three grounds:

1. No references of record teach or suggest "automatic" detection of prescription orders.

As currently amended, independent claims 1 and 5 include limitations to automatically detecting a prescription order. As explained more fully in the specification of the present application, such automatic detection eliminates a primary cause of pharmacy worker error—the worker failing to properly operating the scanning device.

Applicants maintain that Denenberg teaches away from automatic tracking of prescription orders by disclosing how pharmacy workers must first operate a common scanner to read each individual prescription and then receive and follow instructions from a computer system as to where that prescription must be placed in the storage device.

In light of the foregoing distinction, applicants maintain that independent claims 1 and 5 are now in condition for allowance. Moreover, since dependent claims 2-4, 6, and 8-20 depend on one of these now allowable claims, they too should be in condition for allowance.

Serial No. 09/829,536
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2. No teaching to group the plurality of prescription orders together in a common carrier and to electronically bundle a plurality of prescription orders from the same customer together using the common carrier

As currently amended, all of the pending claims include limitations that the plurality of prescription orders for the same customer be grouped together in a common carrier and electronically associated with each other. As explained more fully in the specification of the present application, this bundling facilitates tracking through the pharmacy and retrieval of all of the customer's filled prescription orders upon pickup.

Applicants continue to maintain that none of the references of record teach or suggest such features. U.S. Patent No. 5,794,213 to Markman ("Markman") individually labels and tracks each item in a customer's order as they are separated from each other during various laundry cleaning processes. The tracking system in Markman merely facilitates collection of all of a customer's items prior to pick-up.

In contrast to Markman, the present invention bundles all of a customer's prescription orders together in a common carrier and tracks the common carrier through the pharmacy. No references of record, including Markman and Denenberg, teach or suggest such a feature.

3. Detachable tracking tags & Tag readers at each cubby

Applicants respectfully traverse the examiner's comments that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a detachable tag with the invention of Denenberg et al, so that the tags may be re-used." The examiner has cited no references to teach or suggest such a combination as claimed in claim 11.

Similarly, applicants respectfully traverse the examiner's comment that "[I]t would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a tag reader in each cubby, to reduce the workload of the worker and reduce error."

The level of skill in the art cannot be relied upon to provide the suggestion to combine references. (MPEP § 2143.01). Accordingly, applicants continue to respectfully traverse the examiner's comments regarding this issue.

Serial No. 09/829,536
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4. No teaching to combine references

Similarly, while McCullough discloses a customer notification display system, there is no teaching or suggestion in any references of record to use such a system in a pharmacy in accordance with the limitations of claims 2-4 and 16-19. Accordingly, these claims should also be allowable on these grounds.

In view of the foregoing, applicants submit that all of the currently pending claims are in condition for allowance, and respectfully request that the case be passed to issuance. If the Examiner has any questions, he is invited to contact applicants' attorney at the below-listed telephone number.

Respectfully submitted,

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